



Paper No. 8

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JUL 23 2002

OFFICE OF PETITIONS

In re Application of
Sierra et al.
Application No. 09/924,156
Filed: August 7, 2001
Attorney Docket No. 11325-84822

DECISION DISMISSING
PETITION

This is a decision on the petition under 37 CFR 1.47(a), filed on April 12, 2002, requesting that 3 inventors be allowed to file the application on behalf of themselves and the remaining joint-inventor who allegedly refuses to join in this application.

The petition is **DISMISSED**.

Background

There are 4 joint-inventors for the claimed invention in this application: Rafael A. Sierra ("Sierra"), Mirko Mirkov ("Mirkov"), Kathleen I. McMillan ("McMillan"), and Jennifer R. Lloyd ("Lloyd"). The application as filed on August 7, 2001 included a declaration that was not executed as required by 37 CFR 1.51(b)(2) and as specified in 37 CFR 1.63. A Notice to File Missing Parts of Nonprovisional Application was mailed on September 13, 2001 ("9/13/01 Notice") stating, *inter alia*, that the declaration was not signed. Applicants were given an extendable, non-statutory, 2-month period within which to submit a properly signed oath/declaration and the other missing items.¹ The instant petition was filed in response to the 9/13/01 Notice, and encloses a request for a 5-month extension of time and the requisite fee for filing these items.²

Petition

The instant petition, which presents a "Joint Declaration for Patent Application" signed by only Sierra, Mirkov and Lloyd, requests that these joint-inventors be allowed to file this application on behalf of themselves and McMillan who allegedly refuses to join in this application.

Sierra, Mirkov and Lloyd may file this application on behalf of themselves as well as McMillan, provided that a *bona fide* attempt has been made to present to McMillan for signature a copy of

¹ See MPEP 710.02(d) (Aug. 2001). The 2-month period for reply to a Notice of Missing Parts is not identified in the Notice as a statutory period subject to 35 U.S.C. 133. Thus, a maximum of 5 months may be obtained under 37 CFR 1.136(a), extending the due date for the missing items to 4/15/02, a Monday.

² The petition and the accompanying missing items indicated in the 9/13/01 Notice are timely submitted. See *id.*

the **entire** application, **including the specification, claims, drawings**, and oath/declaration,³ and that McMillan refuses to join in this application. To show that McMillan has refused to join in this application despite a *bona fide* attempt made to present to her for signature a copy of the **entire** application, the petition must include, *inter alia*, a **statement of facts** concerning the circumstances of the presentation of the application papers to McMillan at her last known address,⁴ and her subsequent refusal.⁵

The instant petition and the supporting declaration of Sierra ("Sierra Declaration"), the first-named inventor in this application, delineate how certain documents, including "a copy of the application,"⁶ had been forwarded to McMillan on November 30, 2001 for signature, and that the latter has received the copy of the application⁷ along with other documents but refused to sign the application papers sent to her.⁸

A copy of the transmittal letter for the November 30, 2001 mailing mentioned in the Sierra Declaration is also enclosed with the petition. The Office notes that contrary to the statements in the petition and the Sierra Declaration that "a copy of the application" was sent to McMillan, apparently only a "Background of the Invention"⁹ and "copies of case study (photos)"¹⁰ were

³ MPEP section 409.03(d) (Aug. 2001) REFUSAL TO JOIN (A refusal by an inventor to sign an oath/declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join in the application unless it is clear that the inventor understands exactly what he is being asked to sign and refuses to accept the application papers.); also citing *In re Gray*, 115 U.S.P.Q. 80 (Comm'r Pat. 1956) (It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath/declaration is directed.).

⁴ 37 CFR 1.47(a); also see MPEP section 409.03(e) (Aug. 2001) (An application filed under 37 CFR 1.47 must state the last known address of the non-signing inventor . . . at which the inventor customarily receives mail, . . . [o]rdinarily . . . the last known residence).

⁵ The statement(s) of facts must be made and signed by those who presented the application papers to McMillan/concluded that McMillan refused to join in/to whom McMillan's refusal to join in was made. See MPEP section 409.03(d) (Aug. 2001).

⁶ Petition: page 1, paragraph 2; page 2, last sub-paragraph under paragraph 3, lines 1-2.
Sierra Declaration: page 1, paragraph 2.

⁷ Petition, page 2, last sub-paragraph under paragraph 3, lines 5-6.
Sierra Declaration, page 1, paragraph 3, 2nd sentence.

⁸ Petition: page 1, paragraph 2, last 2 lines; page 2, last sub-paragraph under paragraph 3, last 2 lines; page 3, top 2 lines.
Sierra Declaration: page 1, paragraph 3, last sentence; page 2, paragraph 4.

⁹ 11/30/01 transmittal letter, item no. 4.

¹⁰ 11/30/01 transmittal letter, item no. 5.

provided to McMillan in addition to the application declaration/power of attorney, an assignment, and the filing receipt for the application.¹¹ Therefore, the Sierra Declaration has not supplied any evidence that a copy of the **entire application, including the specification, claims, drawings**, was mailed to McMillan with the November 30, 2001 transmittal letter, or at any other time before or after that date. Consequently, the Office is unable to conclude that the Sierra Declaration constitutes the "statements of facts" required for granting a petition under 37 CFR 1.47(a).¹² The instant petition is thus dismissed.

Options

To prevent abandonment of this application,¹³ Applicants must file within **TWO (2) MONTHS** from the mailing date of this decision.¹⁴

-an oath/declaration properly executed by **all 4** joint-inventors including McMillan;¹⁵ **or**,

-a request for reconsideration of this decision (renewed petition under 37 CFR 1.47(a)) (no fee), that:

-includes appropriate **statement(s) of facts**,¹⁶ stating that the **entire application papers, including the specification, claims, drawings**, and oath/declaration, were presented to McMillan at her last known address; and of the facts relied upon to conclude that McMillan refuses to join in this application;¹⁷ and

-is addressed as follows:

¹¹ Items 1-3 in 11/30/01 transmittal letter. There are only 5 items listed in this transmittal.

¹² See supra note 3.

¹³ See 37 CFR 1.53(f) (If an application which has been accorded a filing date . . . does not include an oath or declaration by the applicant pursuant to § 1.63 . . . , applicant will be notified and given a period of time within which to . . . file an oath or declaration . . . and pay the surcharge required by § 1.16(e) to avoid abandonment.).

¹⁴ Unless proper extension(s) of time under 37 CFR 1.136(a) is (are) obtained.

¹⁵ **To be submitted directly to the Office of Initial Patent Examination** (which issued the 9/13/01 Notice) **by attaching copies of the 9/13/01 Notice and this Decision.**

¹⁶ See supra note 5. If a renewed petition under 37 CFR 1.47(a) is still proper, the "Joint Declaration for Patent Application" enclosed with the instant petition **does not need to be resubmitted.**

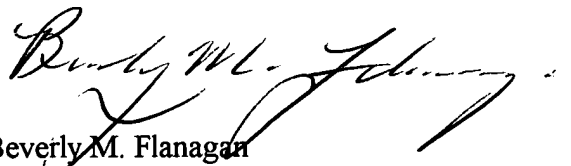
¹⁷ To ensure grantability of the renewed petition under 37 CFR 1.47(a), the signing inventors must, if not having already done so, **provide** McMillan with a copy of the entire application papers and allow her reasonable time to review before deciding whether to sign.

by mail/by hand: Assistant Commissioner for Patents
Attn: Office of Petitions
Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

by fax: (703)308-6916
Attn: Office of Petitions

Finally, the Office acknowledges receipt with the instant petition of an authorization to charge Deposit Account No. 19-0733 for: the \$370 basic filing fee for this application, the \$42 for 1 independent claim in excess of 3, the \$65 surcharge for late filing of the declaration, all in small entity amounts, and the \$130 petition fee; as well as receipt on May 6, 2002 of an assignment document for recordation in the USPTO, and on June 19, 2002 of an Information Disclosure Statement.

Telephone inquiries concerning this decision should be directed to Petitions Attorney RC Tang at (703) 308-0763.



Beverly M. Flanagan
Supervisory Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy